Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte EDWARD E. KELLEY and NORMAN J. DAUERER

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Appeal No. 2002-0633
Application No. 08/978,012

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ON BRIEF

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Before THOMAS, FLEMING, and GROSS, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1 through 20.

Representative claim 1 is reproduced below:

1. A process for updating desired Internet addresses at a client computer comprising the steps of:

a) providing a plurality of client computers, a database accessible by each of said client computers, a network server through which said client computers may access files on the Internet network, and a database accessible by said network server;

b) providing in the client computer database a unique list of Internet addresses, for each client computer, for accessing desired files on said Internet network by the client computer;

c) providing in the network server database a list of Internet addresses for said desired files on said network and addresses of said client computers that have accessed said desired files on said network;

d) receiving notification of new Internet addresses, at the network server, from owners of said desired files;

e) updating in the network server database at least one of said addresses for said desired files on said network; and

f) transferring from said network server database to the database of said client computers having addresses in said network server database the updated at least one of said addresses for said desired files on said network.

The following references are relied on by the examiner:

Inakoshi	5,933,604	Aug. 3, 1999 (filing date Nov. 5, 1996)
Noble	5,978,842	Nov. 2, 1999 (filing date Jul. 18, 1997)

Claims 1 through 20 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Noble in view of Inakoshi.

Rather than repeat the positions of the appellants and the examiner, reference is made to the briefs and the answer for the respective details thereof.

OPINION

We reverse.

Clause d) of independent claim 1 on appeal recites "receiving notification of new Internet addresses, at the network server, from owners of said desired files." Clause e) of this claim recites a feature of updating in the network server database at least one of the Internet addresses for the desired files on the network and, finally, clause f) recites the feature of transferring from the network server database to the database of the client computers this new updated address. Corresponding features are recited in each of the other independent claims 9, 16 and 20 on appeal.

The focus of the arguments between appellants and the examiner revolves around these features.

Both Noble and Inakoshi teach sophisticated passive monitoring only arrangements on the Internet by which users/clients may otherwise seek and/or receive updated web page information associated with corresponding servers.

As repeatedly argued by appellants in the brief and reply brief, Noble does not teach or suggest that an Internet network server receives new Internet addresses from the owners of the files desired by the client computer as in representative

independent claim 1 on appeal. We generally agree with the appellants' observations that in Noble it is the users or the client computers associated with the users that themselves in part determine that a web page has changed in some manner. It is mainly the monitoring systems of both references that merely determine that a change has occurred. In fact, in Noble the reader is taught nothing about the owners of the files associated with the servers in this reference since the reference itself appears to be silent as to this claimed feature. Even though the change notifications taught extensively in Noble may include a changed address such as web page documents being moved to another URL as taught at column 13, line 55 through 59, it is not taught or suggested in Noble that it is the owners of the web page associated with the URL that cause the Internet address to change, and that the change is to occur at a network server that actively sends it to a user/client.

Correspondingly, in Inakoshi it is indicated at column 2 lines 10-24, that a resource is image and text information that a sender creates and sends out such as through a home page on the Internet and that can be updated by that sender. Even if we assume for the sake of argument that the sender in this instance is or corresponds to the claimed owner of the resource, and

assume that the sender may send out address change information of the noted home page, there is no teaching or suggestion in this reference that any address changes that may be effected by the sender at a network server are caused by that server to be transferred to the database of the accessing client computer as claimed. Inakoshi does not teach or suggest the further requirement of clause c) of representative claim 1 on appeal that the network server database maintains a list of addresses of accessing client computers that have accessed the desired files, a feature not found in Noble either. Noble's change detection web server 30 controls monitoring for changes and is not the same as the source document server 12. It is on the basis of the network server storing this client address list in clause c) that the updated address is actually transferred by the network server to a listed client computer database in clause f) of representative claim 1 on appeal. In Inakoshi it is the entire network resource monitoring system of this reference that monitors changes and causes this transfer to occur.

Thus, assuming for the sake of argument within 35 U.S.C. § 103 that the teachings and suggestions of both references are properly combinable within 35 U.S.C. § 103, all of the features of independent claims on appeal are not met.

We are not persuaded by the examiner's basic view that the client computer/user is or corresponds to the owner of the claimed desired files. Notwithstanding the fact that appellants do not provide support in the specification or drawings to otherwise define an owner as a unique entity, we do not go so far as to agree with the examiner's view that a user with privileges to make modifications or changes to an Internet address amounts to an owner as expressed at the bottom of page 10 of the answer. While this may be true in some instances in the art as a whole, neither Noble nor Inakoshi teaches or suggests that any user/client computer is an owner of accessible files. Likewise, the mere fact that Noble's teaching does not exclude an owner as a user or a user as an owner, does not amount to a teaching or suggestion within 35 U.S.C. § 103 to lead us to agree with the examiner's view that therefore, ipso facto, a user is an owner for purposes of claim interpretation. Appellants' reliance at pages 2 and 3 of the reply brief on Black's Law Dictionary is not well taken since a definition from a technical dictionary of common Internet usages would have been more persuasive.

All of these remarks constitute substantive reasons based upon the teachings and suggestions of both references to reverse the rejection of the claims on appeal. The examiner's

formulation of the statement of the rejection also is subject to the appellants' assertion at page 6 of the principal brief on appeal that the examiner has not established a prima facie case of obviousness within 35 U.S.C. § 103. The examiner merely asserts at page 6 of the answer that, "the list of monitoring destinations of Inakoshi shows how the architecture of Noble et al. could be modified with the same outcome of automatically notifying the user of changes to a desired URL," (emphasis added). A valid rejection within 35 U.S.C. § 103 demands a conclusion that it would have been obvious to have performed the modification by an artisan rather than mere speculation that one reference "could be modified" in view of another.

In view of the forgoing, the decision of the examiner rejecting claims 1 through 20 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS Administrative Patent Judge	)	
MICHAEL R. FLEMING Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ANITA PELLMAN GROSS Administrative Patent Judge	)	

JDT/hh

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